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LAWRENCE BERKELEY  
NATIONAL LABORATORY  
ONE CYCLOTRON ROAD, MAIL STOP 90B  
UNIVERSITY OF CALIFORNIA  
BERKELEY CA 94720

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**JUN 19 2006**

**OFFICE OF PETITIONS**

In re Application of  
Tomsia, et al.  
Application No. 09/845,597  
Filed: 30 April, 2001  
Attorney Docket No. 1B-1627

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**ON PETITION**

This is a decision on a petition filed on 27 April, 2006, under 37 C.F.R. §1.137(b).

For the reasons set forth below, the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

**BACKGROUND**

The record indicates:

- Petitioner failed to reply timely and properly to the Notice of Non-Compliant Appeal Brief mailed on 18 July, 2005, with reply due absent extension of time on or before 18 August, 2005;
- the instant application went abandoned by operation of law after midnight 18 August, 2005;
- Petitioner filed an Appeal Brief on 28 November, 2005;
- the Office mailed a Notice of Dismissal of Appeal on 28 March, 2006, for failure to satisfy the 18 July, 2005, Notice;

- Petitioner filed the instant petition on 27 April, 2006, with fee, reply in the form of request for continued examination, fee and submission under 37 C.F.R. §1.114,<sup>1</sup> and made the statement of unintentional delay—thus, Petitioner appears to have satisfied the regulatory requirements under 37 C.F.R. §1.137(b).

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>2</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>3</sup>

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<sup>1</sup> Petitioner has submitted arguments set forth in an Appeal Brief, see the commentary at MPEP §706.07(h)II, which provides in pertinent part:

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#### **II. SUBMISSION REQUIREMENT**

A "submission" as used in 37 C.F.R. 1.114 includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. See 37 C.F.R. 1.114(c). If a reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of 37 C.F.R. 1.111. See 37 C.F.R. 1.114(c). Thus, an applicant may file a submission under 37 C.F.R. 1.114 containing only an information disclosure statement (37 C.F.R. 1.97 and 1.98) in an application subject to a notice of allowance under 35 U.S.C. 151, but not in an application where the last Office action is a final rejection or an Office action under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935), or in an application that is under appeal. A request for a suspension of action, an appeal brief or a reply brief (or related papers) will not be considered a submission under 37 C.F.R. 1.114. See 37 C.F.R. 1.103 and 1.114(d). The submission, however, may consist of the arguments in a previously filed appeal brief or reply brief, or may simply consist of a statement that incorporates by reference the arguments in a previously filed appeal brief or reply brief. In addition, a previously filed amendment after final (whether or not entered) may satisfy this submission requirement.

Arguments submitted after final rejection, which were entered by the examiner but not found persuasive, may satisfy the submission requirement if such arguments are responsive within the meaning of 37 C.F.R. 1.111 to the Office action. Consideration of whether any submission is responsive within the meaning of 37 C.F.R. 1.111 to the last outstanding Office action is done without factoring in the "final" status of such outstanding Office action. Thus, a reply which might not be acceptable as a reply under 37 C.F.R. 1.113 when the application is under a final rejection may be acceptable as a reply under 37 C.F.R. 1.111.

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<sup>2</sup> 35 U.S.C. §133 provides:

#### **35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>3</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

Delays in responding properly raise the question whether delays are unavoidable.<sup>4</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>5</sup> And the Petitioner must be diligent in attending to the matter.<sup>6</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>7</sup>))

Allegations as to  
Unintentional Delay

The requirements for relief under the provisions of 37 C.F.R. §1.137(b) are: petition, fee, reply, showing of unintentional delay, and—where appropriate—a terminal disclaimer and fee

It appears that Petitioner has satisfied the requirements of the regulation.

CONCLUSION

Because Petitioner appears to have satisfied the regulatory requirements, regulation, the petition under 37 C.F.R. §1.137(b) is **granted**.

The application is released to the Examiner in Technology Center 1700 for further processing in due course.

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<sup>4</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>5</sup> See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>6</sup> See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

<sup>7</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

A handwritten signature in black ink, appearing to read "John J. Gillon, Jr.", with a stylized, cursive script.

John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions